



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,705	03/17/2000	Robert A. Luciano	732.083	3145
21707	7590	12/23/2004		
IAN F. BURNS & ASSOCIATES 1575 DELUCCHI LANE, SUITE 222 RENO, NV 89502			EXAMINER ONEILL, MICHAEL W	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/527,705	Applicant(s) LUCIANO, ROBERT A.	
	Examiner Michael O'Neill	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, 70, 80, 81, 83 and 84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, 70, 80, 81, 83 and 84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3713

DETAILED ACTION

Response to Amendment

The status of claim 51 and 51 itself is missing in the most recently filed amendment. It appears from the last amendment to be cancelled.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a single random selection process that determines all outcomes displayed by a first game of chance outcome display and a second game of chance outcome display during a game cycle, including any changes of the first game of chance outcome display and the second game of chance outcome display must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

Art Unit: 3713

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to, the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76, 77, 80, 81, 83 and 84 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a single random number generation means because all games of chance utilize such mechanisms, does not reasonably provide

Art Unit: 3713

enablement for a single random selection process that determines all outcomes displayed by a first game of chance outcome display and a second game of chance outcome display during a game cycle, including any changes of the first game of chance outcome display and the second game of chance outcome display. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The Examiner does not require the Applicant to show a random number generation means because such are known in the art. However, what the Applicant is now claiming is unclear with respect to whether one random number determines all outcomes of all the games within one game cycle; or a single random number generator is used to output the random numbers needed to determine the outcomes of the games. The specification is sparse in description when it comes to the claiming of this embodiment; it is only mentioned once in the specification.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, 70, 80, 81 and 83-84 are rejected under 35 U.S.C. 103(a) as

Art Unit: 3713

being unpatentable over Mayeroff in view of Stanley further in view of Crawford et al. and further in view of Sunaga et al., USPN 6,106,393.

What Mayeroff, Stanley and Crawford disclose, teach and suggest to one of ordinary skill in the art and how these references find the claimed invention as obvious has been previously discussed in the last office action on the merits and is incorporated herein. What the references lack in clearly disclosing is a single random number generation means to generate all outcomes for a single game cycle. As shown in Sunaga et al. in figure 7, for example, is utilization of a single random number generation to determine the outcomes of all games within a single game cycle, stepping through the flowchart. This is how a majority of the gaming machines work in this art; by generating the number, storing it comparing to a table of numbers and resolving the outcome. Thus, one of ordinary skill in the art would find it obvious to combine the teachings of Sunaga et al. into the other references cited previous because a majority of gaming machines utilize a single random number generator to determine the outcome of the game, e.g. whether the game is a win or loss and the amount paid.

Claims 37-40, 45-49, 74, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff in view of

Stanley further in view of Crawford et al further in view of Kaku and further in view of Sunaga et al.

What Mayeroff, Stanley, Crawford and Kaku disclose, teach and suggest to one of ordinary skill in the art and how these references find the claimed invention as obvious has been previously discussed in the last office action on the merits and is incorporated herein. What the references lack in clearly disclosing is a single random number generation means to generate all outcomes for a single game cycle. As shown in Sunaga et al. in figure 7, for example, is utilization of a single random number generation to determine the outcomes of all games within a single game cycle, stepping through the flowchart. This is how a majority of the gaming machines work in this art; by generating the number, storing it comparing to a table of numbers and resolving the outcome. Thus, one of ordinary skill in the art would find it obvious to combine the teachings of Sunaga et al. into the other references cited previous because a majority of gaming machines utilize a single random number generator to determine the outcome of the game, e.g. whether the game is a win or loss and the amount paid.

Response to Arguments

Applicant's arguments filed 9-27-04 have been fully considered but they are not persuasive. The Examiner understands

Art Unit: 3713

that a number of references are being use to reject the claims. However, because the specification is sparse with respect to the workings of the new added limitations, the Examiner can only assume that is part of the disclosure is well known material; otherwise, a fuller disclosure of the material would have been made at the time the patent application was filed. Thus, the Examiner has just provided an exemplary teaching of what the Examiner perceives as well-known subject matter to those skilled in the art. Moreover, to which the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner is providing other references that expressly disclose a single random number generation means.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3713

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MON

A handwritten signature in black ink, appearing to read "mle mlc", is written over the signature block.

MICHAEL O'NEILL
PRIMARY EXAMINER